

## **REMARKS / ARGUMENTS**

### **A. GENERALLY**

Claims 1- 38 remain in this application. Claim 1 has been amended. No new matter has been added by the amendments made herein.

### **B. CLAIM REJECTIONS**

1. Claims 1-8, 11-12, and 31-32 have been rejected as being unpatentable under 37 CFR §103(a) over U.S. Pub. No. 2005/0054351 filed by McAlexander (herein, “McAlexander”) in view of U.S. Patent 6,243,039 to Elliot (herein, “Elliot”) in further view of U.S. Pub. No. 2005/0130680 filed by Northcutt (herein, “Northcutt”).

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (MPEP §2143.03; 8th Ed, Rev. 2; citations omitted.) Further, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination..... Although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.’” (MPEP §2143.01 III; 8<sup>th</sup> Ed., Rev. 3; citations omitted.)

The Federal Circuit has repeatedly warned against using an applicant’s disclosure as a blueprint to reconstructed the claimed invention out of isolated teachings of the prior art. *See, Grain Processing Corp. v. American Maize Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). This principle is also embodied in prohibition against the application of hindsight:

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then accepted wisdom in the field. ...Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.” (*In re Kotzab*, 217 F.3d 1365, 1359, 55 USPQ2d 1313, 1316 (citations omitted) (Fed. Cir. 2000).)

Applicant submits that the combination of McAlexander, Elliot, and Northcutt amounts to reconstruction of the elements of claim 1 (as amended) from isolated teachings of the prior art using hindsight. Even assuming that the limitations of claim 1 could be found in the cited references, the motivation to combine them must be found in the references themselves. Applicant respectfully submits that no such motivation may be found in the cited references.

Additionally, the MPEP recognizes that “[I]t is improper to combine references where the references teach away from their combination.” (MPEP, §2145 X.D.2; 8<sup>th</sup> Ed., Rev. 3; citations omitted.)

The office action concluded that it would have been obvious to one skilled in the art to modify McAlexander to incorporate the teachings of Elliot to establish a location rule for a monitored device and to further modify that combination to incorporate Northcutt to report the location of the monitored device to the monitored device if the monitored device is in violation of the location rule. Applicant submits that the blueprint for this modification of McAlexander is not Elliot or Northcutt but the teachings and disclosures of the present application.

McAlexander describes a location tracking system comprising a primary base station 110, primary mobile unit 120, and secondary mobile units 130 and 140, associated with primary mobile unit 120. Primary base station 110 monitors the locations of one of more primary mobile units and one or more secondary mobile units that are attached to, or carried by, for example, a group of persons, a group of animals, a group of vehicles, and the like. Primary base station 110 may communicate directly only with primary mobile units, using either paging transceiver 220 or local RF transceiver 230. The primary base station 110 communicates with secondary mobile units indirectly using primary mobile unit 120. In this manner, location information is relayed from secondary mobile units 130 and 140 to primary base station 110 through primary mobile unit 120. Additionally, primary base station 110 is capable of communicating over line 115 via a wireline interface with an external communication network (not shown), such as the Internet or an Ethernet local area network (LAN). This allows primary base station 110 to exchange location information with other primary base stations.

The office action combines a pre-specified threshold feature disclosed by Elliot with the tracking system disclosed by McAlexander.

The present invention also provides a process of auto-notification to a monitoring party, when the device movement exceeds a pre-specified threshold. The pre-specified threshold may be a minimum change in a location, a movement outside a designated range, or a movement beyond a certain distal radius. The designated range may be specified in terms of a zip code or a city boundary. For example, if a device's location data, as read and analyzed by a centralized computer system, indicates the device has moved more than an "n" mile radius from a central location, an automatic page, telephone call, e-mail, or other means, is sent to a parent or other specified receiver. Thus, the present invention enables automatic notification when the device's location data exceeds the pre-specified allowed location range. (Elliot, Col. 3, lines 23-37; emphasis added by underlining).

Applicant respectfully submits that Elliot describes using a fixed, central computer that determines that a device has exceeded a pre-specified threshold and reports that determination to another (not the device). McAlexander does not contemplate the use of a central computer system, but rather teaches the use of one or more base stations that may be mobile. The base station of Alexander is directed to receiving location data, not analyzing and processing location data against a set of pre-specified thresholds. Requiring the base station of McAlexander to perform the analysis of location data relative to a pre-specified threshold and to possess the capability to report the results to a primary or secondary unit would substantially alter the principle of operation of McAlexander, which uses a distributed architecture, and require the addition of structural elements to McAlexander to provide it with the computing power process the location data.

The examiner further combines Northcutt with the combination of McAlexander and Elliot. Northcutt is viewed as teaching reporting the location of the monitored device to the monitored device. Northcutt is directed to a mobile phone determining its location, and selecting a location/location icon pairing that is closest to the current position of the mobile phone *as determined by the mobile phone*. (See, Northcutt, ¶20.) This location icon is then displayed on the mobile phone display.

Applicant respectfully submits that Northcutt teaches away from Elliot. Elliot is directed at acquiring location data at a central computing system and reporting a device location to another person or device, such as reporting the location of a device associated

with a child to a parent of that child through various means. Northcutt is directed to determining the location of a device by the device and displaying a representation of that location to the user of the device. Northcutt thus teaches away from the essential elements of Elliot's invention is which a central computer is used to determine a location of a device and the results are reported to a third party or other device. The combination of Elliot with Northcutt is, therefore, improper.

Assuming that the combination of Elliot and Northcutt describe elements directed to establishing a location rule, determining a violation of that rule by a device, and reporting location data of that device to that device in the event the location rule is violated, Applicant respectfully submits that the modification of McAlexander to incorporate these references is not enabled by the references themselves. One of ordinary skill in the art is not guided as to how to make the necessary modifications of the system described by McAlexander without undue experimentation.

Based on the foregoing, Applicant respectfully submits that there is no motivation in the references themselves to combine the references and that a prima facie case of obviousness has not been made.

Even if motivation could be found to combine the cited references, Applicant respectfully submits that the combination does not teach or reasonably suggest the limitations of claim 1, as amended. Claim 1 (as amended) recites the following limitations (the limitations have been labeled for discussion purposes):

1. A system for locating a member of a group, wherein each member of the group comprises a portable wireless monitored device equipped with location means, the system comprising:

[A] the portable wireless device, wherein the portable wireless monitored device is accessible via a wireless network; and

[B] a server accessible via the wireless network, the server adapted to:

[C] receive location data from a first portable wireless monitored device;

[D] establish a location rule for the first portable wireless monitored device;

[E] determine whether the first portable wireless monitored device

is in violation of the location rule established for the first portable wireless monitored device; and  
[F] in the event the first portable wireless monitored device is in violation of the location rule established for the first wireless device, report the location data of the first portable wireless device [G] directly to the first portable wireless monitored device.

The examiner found that McAlexander teaches limitations 1[A]-1[C] but not limitations 1[D]-1[G]. The examiner further determined that limitations 1[D]-1[F] were taught by Elliot, but not limitation [G]. The examiner then determined that limitation [G] was taught by Northcutt.

Applicant submits that the combination of McAlexander, Elliot and Northcutt fails to teach all of the limitations of claim 1 (as amended) because, at a minimum, the combination does not report the location data of the first portable wireless device directly to the first portable wireless device. The office action mapped the server of limitation 1[D] to the primary base station of McAlexander. The server (or primary based station) is adapted to, "in the event the first portable wireless monitored device is in violation of the location rule established for the first wireless device, report the location data of the first portable wireless device directly to the first portable wireless monitored device." (Claim 1, limitations 1[F] and 1[G]). The office action recognized that the combination of McAlexander and Elliot did not teach the limitation to report the location data directly to the first portable wireless monitored device. The office action determined that this limitation was taught by Northcutt. However, Northcutt teaches that location data is generated by the mobile phone (not the server as recited in claim 1) and thus does not teach reporting these data to the mobile phone.

Based on the foregoing, Applicant submits that the combination of McAlexander, Elliot, and Northcutt does not teach or reasonably suggest all of the limitations of claim 1 (as amended). Therefore, the rejection is unsupported by the art and should be withdrawn.

Claims 2-9, 11-12, and 31-32, which have also been rejected over the combination of McAlexander, Elliot and Northcutt, depend directly or indirectly from claim 1 (as amended). For the reasons stated above, the combination of McAlexander,

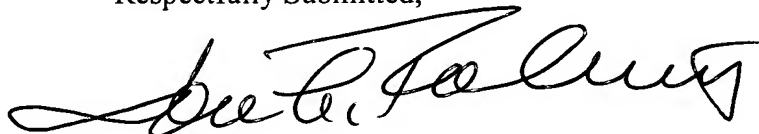
Elliot, and Northcutt does not teach or reasonably suggest all of the limitations of 2-9, 11-12, and 31-32. Therefore, these rejections are unsupported by the art and should be withdrawn.

**C. CONCLUSION**

In view of the above information and remarks, Applicant respectfully requests reconsideration of the current rejections. For the above reasons, Applicant respectfully submits that the application is in condition for allowance with claims 1-38. Should any further questions arise concerning this application or in the event the above amendments do not place the application in condition for allowance, Applicant respectfully requests an interview with the examiner and the examiner's supervisor prior to any new office action relating to the present Application. Attorney for the Applicant may be reached at the number listed below.

The Director of the U.S. Patent & Trademark Office is authorized to charge any necessary fees, and conversely, deposit any credit balance, to Deposit Account No. 18-1579.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Jon L. Roberts", with a stylized flourish at the end.

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